

Application No.: 09/876235

Docket No.: COTH-P07-701

REMARKS

Claims 63-79 constitute the pending claims in the present application. Claim 63 has been amended, which amendment does not introduce any new matter. Applicants respectfully request reconsideration in view of the following remarks.

Rejection of Claims 78 and 79 Under 35 U.S.C. 112, First Paragraph

Claims 78 and 79 stand rejected for allegedly failing to meet the written description requirement. In particular, the Office Action asserts that the specification does not describe an actual reduction to practice with respect to the claim inventions involving “puromycin-like compounds” and “adenine-like compounds,” that the specification does not illustrate those compounds, and that the specification does not describe identifying characteristics of those compounds. Applicants respectfully traverse.

The Office Action cites *Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶1, “Written Description” Requirement* appeared in January, 2001, in the Federal Register, Vol. 66, No. 4, pp. 1104-1111. The *Guidelines* states with respect to original claims drawn to a genus:

“[t]he written description requirement... may be satisfied through sufficient description of a representative number of species by actual reduction to practice..., reduction to drawings..., or by disclosure of relevant, identifying characteristics, i.e., structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus....

... What constitutes a “representative number” is an inverse function of the skill and knowledge in the art. Satisfactory disclosure of a “representative number” depends on whether one of skill in the art would recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus in view of the species disclosed.” *Guidelines*, page 1106, right column.

Further, Applicants point out that “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the written description requirement.” MPEP 2163.02. The test, rather, is whether the disclosure “reasonably conveys to the skilled artisan that the inventor had possession at that time of the ... claimed subject matter.” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983)). Indeed, the courts

Application No.: 09/876235

Docket No.: COTH-P07-701

have repeatedly criticized “hypertechnical applications” of the written description requirement (see, for example, *In re Johnson*, 194 USPQ 187 (CCPA 1977), *In re Driscoll*, 195 USPQ 434 (CCPA 1977)) that require overly explicit support for the claimed invention, rejections that would only motivate applicants to “increase that surfeit of verbiage which has for long been the curse of patent practice, and has done much to discredit it.” *Engineering Development Laboratories v. Radio Corp. of America*, 153 F.2d 523, 526-27 (CA2 1946).

With respect to the issue of reduction to practice, Applicants point out that the specification, in the examples and figures, provides detailed description for the practice of the claimed invention with puromycin. Based on the detailed description, one of skill in the art would recognize that Applicants were “in possession of the necessary common attributes or features of the elements possessed by the members of the genus.” A skilled artisan would recognize the chemical mechanism underlying the illustrated reactions to make a puromycin-oligonucleotide conjugate, see Figures 3 and 4, which would be common to using a puromycin-like or adenine-like compound to make a conjugate for practicing the claimed inventions.

With respect to the issue of drawings, Applicants submit that a person having ordinary skill in the art would envision, based on “the necessary common attributes” possessed by puromycin, puromycin-like or adenine-like compounds that can be used to practice the claimed invention. To require actual drawings for those compound would lead to “surfeit of verbiage,” which is disfavored by the courts.

With respect to the issue of describing identifying characteristics, Applicants submit that the detailed description regarding puromycin, such as for example in Figures 3 and 4, would allow a skilled artisan to readily recognize the identifying characteristics that would be required of a puromycin-like or adenine-like compound for practicing the claimed inventions.

As stated in the *Guidelines* quoted above, Applicants are not required to describe more than a “representative number” of members in the genus. Puromycin and adenine were very well known and characterized at the effective filing date of the instant application, and a skilled artisan would recognize what puromycin-like and adenine-like compounds are based on the ordinary meaning of these terms. Given the level of knowledge and skill in the art, Applicants submit that the specification, particularly the description regarding puromycin, “reasonably conveys to the skilled artisan” that Applicants had possession of the claimed inventions.

Accordingly, reconsideration and withdrawal of the rejections are respectfully requested.

Application No.: 09/876235

Docket No.: COTH-P07-701

Rejections Under 35 U.S.C. 102(e)

Claims 63-76 and 78-79 stand rejected as allegedly anticipated by Gold et al. (U.S. Patent No. 5,843,701). The Office Action states that Gold et al. teach a nucleic acid-protein molecule, wherein the nucleic acid portion and the protein portion is cross-linked through a tRNA.

Gold et al. teach mRNA:polypeptide copolymers, and in the disclosed examples, the copolymers are part of a ribosome complexes. Gold et al. also teach that biotin may be used to make those copolymers and speculate that a particular tRNA specie containing a "Y" base might provide a stable linkage between an mRNA and a polypeptide in a copolymer. Gold et al. do not provide any guidance on how to make such tRNA-cross linked copolymer.

Nevertheless, to expedite prosecution, Applicants have amended the claim 63, to exclude tRNA from the genus of peptide acceptors that can be used to practice the claimed inventions. Such amendment does not introduce any new matter, because the instant application recites tRNA as a peptide acceptor. *See* MPEP 2173.05(i) (stating that "[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. . .").

In view of the amendment, reconsideration and withdrawal of the rejections are respectfully requested.

Double-Patenting Rejections

Claims 65-72 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 6,258,558.

Claims 63-64 and 77-79 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 1-18 [sic].

Claims 63-64 and 77-79 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,214,553.

Applicants will submit a terminal disclaimer for each of the patents cited above, if necessary, upon indication of allowability.

Application No.: 09/876235

Docket No.: COTH-P07-701

CONCLUSION

In view of the above amendments and remarks, Applicants believe that the pending application is in condition for allowance.

Enclosed is a three-month Petition for Extension of Time and payment of the required fee. Applicants believe that no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. COTH-P07-701 from which the undersigned is authorized to draw.

Dated: December 19, 2005

Respectfully submitted,

By 

John D. Quisel

Registration No.: 47,874

FISH & NEAVE IP GROUP

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110-2624

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant